

REMARKS/ARGUMENTS

The claims are 26-29 and 36-37, claims 30-35 and 38-39 having been withdrawn from consideration by the Examiner as directed to a non-elected invention. Claim 26 has been amended to recite that the pin is provided with a chamfer. Support for the claims may be found, inter alia, in the disclosure at page 13, lines 1-5 and FIG. 5. Reconsideration is expressly requested.

Claims 26-29 were rejected under 35 U.S.C. § 102(b) as being anticipated by *DE 39 03 675 to Gebert et al.* The remaining claims 36 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gebert et al.* in view of *Baumann et al. U.S. Patent No. 4,906,365* and *Neufeld et al. U.S. Patent No. 6,488,845*, respectively.

Essentially, the Examiner's position was that *Gebert et al.* discloses the ring-shaped filter insert as recited in the claims, except for specifying the retaining means as extending axially and radially in an interior space of the insert which is said to be shown by *Baumann et al.*, and except for specifying an inner frame comprising the retaining means for mounting the insert on a cover of the filter housing for rotational movement of the insert

about its longitudinal axis which is said to be shown by Neufeld et al.

This rejection is respectfully traversed.

As set forth in claim 26, as amended, Applicants' invention provides a ring shaped filter insert for a liquid filter having a filter housing for receiving the insert. The insert includes both (a) a pin that projects eccentrically and runs parallel to a longitudinal axis of the filter insert and is integrally molded on a lower end disk of the filter insert and (b) a projection extending axially away from the pin and being formed on an end of the pin facing a ramp of a receiving area of the filter housing when the insert is inserted into the filter housing. The pin is provided with a chamfer and the projection forms a contact zone of the pin.

This chamfer on the pin differs significantly from the projection which forms the contact zone of the pin as recited in amended claim 26. With the help of the chamfer on the pin, inserting of the pin into the discharge channel is easier to perform because the pin is exactly aligned with the discharge channel.

Additionally, as shown in FIG. 5, such a chamfer 44 is very useful for the mounting of the filter element. The o-shaped sealing ring (27) has to be slipped over the free end of the pin (25) in order to insert the sealing ring (27) into a respective ring-shaped groove. With the help of the chamfer (44), the sealing ring is easy to slip over the end portion and into the groove.

None of the cited references discloses or suggests a ring-shaped filter insert having a pin that is provided with a chamfer and a projection as recited in Applicants' claim 26, as amended, or teaches the benefits that accrue from that structure. The primary reference to *Gebert et al.*, which is discussed on pages 1 and 2 of the specification, fails to show such an arrangement. Although the Examiner has taken the position that the lower tapered portion of the pin in *Gebert et al.* constitutes a projection, it is respectfully submitted that Applicants' projection as recited in the claims is significantly different from *Gebert et al.*'s traditional chamfer or tapered portion. In order to achieve an exact alignment of the pin with the discharge channel, the filter insert of *Gebert et al.* has an end disc (5) provided with a radial recess which cooperates with a web radially extending from the wall of the housing (1). The recess

and the web cooperate as a tongue-and-groove-joint (13). See FIGS. 1 and 2 of *Gebert et al.* A drawback of this arrangement is that the "tongue" has to be inserted into the "groove" before fully inserting the filter element into the housing, which requires careful handling.

In contrast, the filter insert as set forth in claim 26, as amended, does not have this drawback. With Applicants' insert, the user inserts the filter element into the housing, then the projection (39) extending axially away from the pin cooperates with the ramp (28) of the housing in order to automatically find an exactly aligned position between pin (25) and discharge channel (24). With this arrangement, easy mounting of a sealing ring and easy inserting of the pin into the discharge channel is made possible. In contrast, the tapered end portion of the pin of *Gebert et al.* is merely a chamfer and not a projection as recited in Applicants' claim 26, as amended.

The defects and deficiencies of the primary reference to *Gebert et al.* are nowhere remedied by any of the secondary references to *Baumann et al.* and *Neufeld et al.*, which were cited with respect to claims 36 and 37, respectively. *Baumann et al.* discloses a filter for cleaning lubricating oil in which the

filter cartridge 6 and the cover 7 are releasably joined together. For this purpose, the cover has on its inside 70 a plurality of spring tongues 71 and 71' with outwardly protruding cap projections 72 and 72' which, when the filter cartridge 6 is inserted into the filter case 2, engage in a matching indentation 65 in the upper end 63 of the filter cartridge. There is no disclosure or suggestion of a ring-shaped filter insert including a pin provided with a chamfer and a projection extending axially away from the pin as recited in Applicants' claim 26, as amended.

Neufeld et al. simply shows an oil filter unit that includes fingertips 118 which assist in securing a center tube or support 28 to the oil filter assembly cover 24. There is no disclosure or suggestion of a filter insert having a pin provided with a chamfer and a projection extending axially away from the pin as recited in Applicants' claims that permits easy mounting of the sealing ring and easy inserting of the pin into the discharge channel.

Accordingly, it is respectfully submitted that the claims are patentable over the cited references. Moreover, it is respectfully submitted that claim 26, as amended, is a generic claim and therefore all species should be considered in this

application, including those independent claims 30-35 and 38-39 which have been withdrawn from consideration by the Examiner.

In summary, claim 26 has been amended. In view of the foregoing, it is respectfully requested that the claims be allowed and that this case be passed to issue.

Applicants also respectfully request that the Examiner formally make of record European Patent Application No. 0 874 140 cited in the German priority case and made of record in parent application, Serial No. 10/111,473, now U.S. Patent No. 6,706,181. A copy of this European patent application and English language abstract thereof is enclosed, together with the Form PTO-1449 accompanying the Information Disclosure Statement filed November 12, 2003 in this case listing this reference.

Respectfully submitted,
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Enclosure: European Patent No. 0 874 140 and English abstract
Copy of PTO-1449 form

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 11, 2005.

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